

Serial No. 10/657,934

Amend. in Resp. to Off. Act. of Mar. 9, 2005

UTILITY PATENT

B&D No. TN2347B

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 3A. This sheet, which includes Fig. 3A, replaces the original sheet including Fig. 3A.

Attachment: Replacement Sheet

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REMARKS

Currently in the Application are Claims 1-20.

The Examiner objected to the drawings under 37 CFR § 1.84(p)(4). In particular, the reference numeral "406" has been used to designate two different elements in FIG. 3A. In response, Applicants have amended FIG. 3A to use a different numeral for screw 407.

In addition, the Examiner noted that reference character "52" was used to designate a body, a knife and a clamp. In response, Applicants have amended the specification to properly reference to body 51, knife 53 and clamp 52.

The Examiner also objected to the drawings under 37 CFR § 1.84(p)(5) for including a numeral not mentioned in the description. In particular, the Examiner objected to reference numeral "120." Applicants point out that such reference numeral can be found in para. 0029 of the Specification. Therefore, no amendment to the drawings is required under this objection.

The Examiner objected to the specification for including several unclear phrases. In response, Applicants have deleted such phrases.

The Examiner rejected to Claim 3 under 35 USC § 112, second paragraph, for indefiniteness. This rejection is respectfully traversed.

The Examiner noted that "it is unclear what the speed selector handle is controlling, i.e. the speed of what?" In response, the Applicants note that the function of the claimed speed selector handle is fully disclosed, for example, in paragraphs 0025 and 0045 of the Specification.

Accordingly, persons skilled in the art will recognize that such handle is used to select different

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cutterhead speeds as fully described in the Specification. Therefore, Claim 3 is definite in view of the Specification.

The Examiner rejected Claims 1, 3-4, 10-11 and 19-20 under 35 USC § 102(b) as being anticipated by US Patent No. 5,771,949 ("Welsh"). The Examiner also rejected Claim 2 under 35 USC § 103 as being unpatentable over Welsh. In addition, the Examiner rejected Claims 12 and 14 under 35 USC § 103 as being unpatentable over Welsh in view of US Patent No. 5,957,173 ("Garcia"). These rejections are respectfully traversed.

For the sake of clarity, Applicants will separately address the rejections to Claims 1, 10 and 19.

Claim 1 calls for a power planer for planing a top surface of a workpiece comprising a base assembly, a carriage assembly disposed above the base assembly, the carriage assembly comprising a cutterhead assembly, the carriage assembly being vertically movable to change the distance between the base assembly and the carriage assembly, a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly, a material removal gauge disposed on the carriage assembly, a switch disposed on the carriage assembly, and a height scale disposed on the base assembly, wherein the material removal gauge, the switch and the height scale are on the front side of the power planer, and the hand crank is substantially on the front half of the power planer.

Admittedly, Welsh discloses a power planer for planing a top surface of a workpiece, the planer having a base assembly, a carriage assembly disposed above the base assembly, the

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carriage assembly comprising a cutterhead assembly, the carriage assembly being vertically movable to change the distance between the base assembly and the carriage assembly, a material removal gauge disposed on the carriage assembly, a switch disposed on the carriage assembly, and a height scale disposed on the base assembly, wherein the material removal gauge, the switch and the height scale are on the front side of the power planer.

However, the Welsh planer does not have a hand crank attached to the carriage assembly. Instead, the hand crank 96 is attached to frame 12. Frame 12 cannot be interpreted to be the carriage assembly, as the carriage assembly must be movable, whereas the frame is fixed.

By contradistinction, Claim 1 requires that the "hand crank [be] attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly." Because Welsh does not teach or suggest such element, it cannot render Claim 1 and its dependent claims unpatentable.

Similarly, Claims 10 and 19 call for "a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly." As discussed above, Welsh does not teach or suggest such element. Thus, it cannot render Claims 10 and 19, and their dependent claims unpatentable.

Furthermore, Welsh does not teach or suggest the nut assembly of Claim 19. The Examiner alleges that reference numeral "96," which refers to the Welsh hand crank, shows the claimed nut assembly. Once again, the Examiner has argued that a certain element which is disposed on the frame is somehow connected to the carriage assembly.

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As discussed above, hand crank 96 is attached to frame 12 and is not attached or connected to the carriage assembly. By contradistinction, Claim 19 requires that "the carriage assembly [comprise] at least one nut assembly threadingly engaging the corresponding at least one guide post." In other words, the nut assembly is part of the carriage assembly. Since hand crank 96 is not part of the carriage assembly, Welsh does not disclose the claimed nut assembly.

Furthermore, even if the hand crank is part of the carriage assembly, there's no element below the hand crank (or along guide post 100) that could be considered the lower plate threadingly engaging the guide post. It appears that the Examiner believes the base or the small plate above reference numeral "48" in FIG. 3 to be the lower plate. However, neither the base nor the plate are threadingly engaged to the guide post.

By contradistinction, Claim 19 requires that the "lower plate threadingly [engage] the corresponding at least one guide post." Because such element is not taught or suggested by Welsh, it cannot render Claim 19 and its dependent claims unpatentable.

Because it is unclear what the Examiner considers to be the lower plate, Applicants cannot answer the Examiner's arguments as to the proper identification of the screw and spring. Accordingly, Applicants request that the Examiner identify the lower plate element in Welsh, either by reference numeral or circling such element in a drawing, so that Applicants can properly respond to the Examiner's arguments.

The Examiner rejected Claim 15 under 35 USC § 103 as being unpatentable over Welsh. This rejection is respectfully traversed.

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Claim 15 calls for a power planer for planing a top surface of a workpiece comprising a base assembly, a carriage assembly disposed above the base assembly, the carriage assembly comprising a motor, a cutterhead assembly driven by the motor, a first roller assembly drivingly connected to the cutterhead, first and second springs disposed between the carriage assembly and the first roller assembly, a second roller assembly drivingly connected to the first roller assembly, third and fourth springs disposed between the carriage assembly and the first roller assembly, the carriage assembly being vertically movable to change distance between the base assembly and the carriage assembly, a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly, a material removal gauge disposed on the carriage assembly, a switch disposed on the carriage assembly, and a height scale disposed on the base assembly, wherein the first and third springs provide unequal forces.

First of all, the Welsh planer does not have a hand crank attached to the carriage assembly. Claim 15 calls for "a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly." As discussed above, Welsh does not teach or suggest such element. Thus, Welsh cannot render unpatentable Claim 15.

Furthermore, the Examiner has improperly argued that it "would have been obvious at the time of the invention to one having ordinary skill in the art to construct Welsh having first and second springs of unequal forces because discovering the optimum value of a result effective variable involves only routine skill in the art." Such argument is improper as the Examiner has failed to prove that such person skilled in the art would modify Welsh in the first place.

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The fact that discovering the optimum value involves only routine skill in the art is irrelevant to a determination of obviousness. *See* MPEP § 2143.01. According to the MPEP, the “fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness.” *Id.* Instead, there must be “some objective reason” to modify the reference as suggested by the Examiner. *See id.* (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999) (The level of skill in the art cannot be relied upon to provide the suggestion to combine references)).

Similarly, the Examiner has only alleged that a person skilled in the art would know how to provide springs of unequal force because of the level of skill in the art. The Examiner however has failed to show (a) that such person skilled in the art would provide such springs, and (b) what knowledge in Welsh or the general existing knowledge would provide the teaching or suggestion to provide such springs of unequal force.

To establish a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.” MPEP § 2143; *see also In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (obviousness rejection reversed because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention).

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Neither Welsh nor the knowledge available to one of ordinary skill in the art teach or suggest using springs providing unequal forces. Certainly, Welsh is silent on such subject. To the best of Applicants' knowledge, the product incorporating the Welsh invention, as well as other planers, have springs that provide equal forces. Accordingly, Applicants submit that neither Welsh nor the knowledge available to one of ordinary skill in the art teach or suggest using springs providing unequal forces. Accordingly, Welsh cannot render Claim 15 unpatentable.

Nonetheless, if the Examiner is aware of any "knowledge available to one of ordinary skill in the art" that teaches or suggests using springs providing unequal forces, the Applicants request that the Examiner disclose such knowledge so that Applicants can fully respond to the Examiner's rejection.

The Examiner rejected Claims 5-9 under 35 USC § 103 as being unpatentable over Welsh in view of US Patent No. 2,792,036 ("Burtke"). Such rejection is respectfully traversed.

Claim 5 calls for a power planer for planing a top surface of a workpiece comprising a base assembly, a carriage assembly disposed above the base assembly, the carriage assembly comprising a cutterhead assembly, the carriage assembly being vertically movable to change the distance between the base assembly and the carriage assembly, a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly, a material removal gauge disposed on the carriage assembly, a switch disposed on the

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carriage assembly, and a height scale disposed on the base assembly, wherein the cutterhead assembly has a main body, and three knives disposed on the main body.

As discussed above, the Welsh planer does not have a hand crank attached to the carriage assembly. Claim 5 calls for "a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly." Welsh does not teach or suggest such element. Neither does Buttke. Thus, the Welsh/Buttke combination cannot render Claim 5 and its dependent claims unpatentable.

The Examiner rejected Claims 16-18 under 35 USC § 103 as being unpatentable over Welsh in view of US Patent No. 5,988,239 ("Chen"). This rejection is respectfully traversed.

Claim 16 calls for a power planer for planing a top surface of a workpiece comprising a base assembly, a carriage assembly disposed above the base assembly, the carriage assembly comprising a motor, a cutterhead assembly driven by the motor, a first roller assembly drivingly connected to the cutterhead, a second roller assembly drivingly connected to the first roller assembly, the carriage assembly being vertically movable to change the distance between the base assembly and the carriage assembly, a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly, a material removal gauge disposed on the carriage assembly, a switch disposed on the carriage assembly, and a height scale disposed on the base assembly, wherein the first roller assembly is lower than the cutterhead assembly.

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First of all, the Welsh planer does not have a hand crank attached to the carriage assembly. Claim 16 calls for "a hand crank attached to the carriage assembly for changing the distance between the base assembly and the carriage assembly." As discussed above, Welsh does not teach or suggest such element. Neither does Chen. Thus, neither Welsh nor the Welsh/Chen combination can render Claim 16 unpatentable.

Furthermore, the Examiner has improperly argued that it "would have been obvious at the time of the invention to one having ordinary skill in the art to construct Welsh having the first and second roller assemblies lower than the cutterhead ... because mere rearrangement of parts of an invention involves only routine skill in the art." Such argument is improper as the Examiner has failed to prove that such person skilled in the art would modify Welsh in the first place.

"The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims ... is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of [applicant's] specification, to make the necessary changes in the reference device." MPEP § 2144.04 (*quoting Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter.1984)).

Similarly, the Examiner has only alleged that a person skilled in the art could rearrange the parts. The Examiner however has failed to show (a) that such person skilled in the art would

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rearrange the parts, and (b) what knowledge in Welsh, Chen or the general existing knowledge would provide the teaching or suggestion for such rearrangement.

Certainly, Welsh is silent on the placement of the roller assemblies in view of the cutterhead. Contrary to the Examiner's statements, Applicants have not found a teaching in Chen suggesting such arrangement either. (Applicants request the Examiner to provide a citation in the Chen specification to such teaching.) To the best of Applicants' knowledge, the product incorporating the Welsh invention, as well as other planers, have roller assemblies disposed at the same height as the cutterhead. Accordingly, Applicants submit that Welsh, Chen or the knowledge available to one of ordinary skill in the art do not teach or suggest providing a roller assembly lower than the cutterhead. Accordingly, neither Welsh nor the Welsh/Chen combination can render unpatentable Claim 16 and its dependent claims.

Nonetheless, if the Examiner is aware of any "knowledge available to one of ordinary skill in the art" that teaches or suggests providing a roller assembly lower than the cutterhead, the Applicants request that the Examiner disclose such knowledge so that Applicants can fully respond to the Examiner's rejection.

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

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In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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